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**APR 04 2006**

**OFFICE OF PETITIONS**

In re Application of	:
John A. Lawton et al	:
Application No. 10/779,865	: SUBSTITUTE
Filed: February 18, 2004	: DECISION ON PETITION
Attorney Docket No. 102456-40308370	: UNDER 37 CFR 1.78(a)(3)
	:

This is a SUBSTITUTE decision on the petition under 37 CFR 1.78(a)(3), filed December 19, 2005, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to prior-filed nonprovisional Application No. 09/948,713, as set forth in the concurrently filed amendment. The decision on petition mailed March 9, 2006 is vacated for the reason stated below.

The petition under 37 CFR 1.78(a)(3) is **GRANTED**.

The decision mailed March 9, 2006 dismissed the petition of December 19, 2005 on the basis that the amendment to add a reference to the above-noted, prior-filed nonprovisional application contained an improper incorporation by reference statement. However, in reviewing the transmittal letter accompanying the application papers, it is noted that an incorporation by reference statement to the above-noted, prior-filed nonprovisional application was in fact present. While it is more appropriate for the incorporation by reference statement to appear in the first sentence of the specification following the title, the Office will accept for purposes of this petition the presence of the incorporation by reference statement in the transmittal letter accompanying this application. For this reason, the decision mailed March 9, 2006 is vacated.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.


The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

**The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed application. In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether this application is entitled to the benefit of the earlier filing date.**

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application, was mailed to applicant on February 18, 2005.

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3218. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to Technology Center Art Unit 1752 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application.<sup>1</sup>

  
Frances Hicks  
Petitions Examiner  
Office of Petitions

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<sup>1</sup> Petitioner should note that failure to timely reply to the final Office action mailed March 17, 2006 will result in the abandonment of the application.